

### **REMARKS**

In the Office Action<sup>[1]</sup>, the Examiner objected to the specification, rejected claims 19 and 20 under 35 U.S.C. § 101, and rejected claims 1-8 and 19-22 under 35 U.S.C. §103(a) as being obvious over *Barrett et al.* (U.S. Patent No. 5,699,532, "*Barrett*") in view of *Sridhar et al.* (U.S. Patent No. 6,098,108, "*Sridhar*"). By this Amendment, Applicants amend the specification and claims 1, 3, 19, and 21, cancel claims 2, 20, and 22, without prejudice or disclaimer, and add new dependent claims 23 and 24. Claims 9-18 have previously been withdrawn. Claims 1, 3-19, 21, 23, and 24 remain pending of which claims 1, 3-8, 19, 21, 23, and 24 are currently under examination.

Applicants thank Examiner Barqadle for the courtesies extended to Applicants' representative during the telephonic interview held on October 21, 2008. During the interview Applicants agreed to make Amendments to independent claims 1, 19, and 21. These suggestions are reflected in the claim listing above.

#### **I. Objection to the Specification**

Applicants respectfully traverse the Examiner's objection to the specification for allegedly "failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. 1.75(d)(1) and M.P.E.P. § 608.01(o)." Office Action, p. 2. Applicants submit the M.P.E.P. does not require word for word correspondence with the specification of the application. The specification of the instant application provides support for the claimed "computer-readable medium." By way of a non-limiting example, Applicants

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<sup>[1]</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

point to page 15, lines 15-20 of the instant specification. Therefore, Applicants respectfully request the Examiner to withdraw the objection to the specification.

## **II. The Rejections of Claims 19 and 20 Under 35 U.S.C. § 101**

The Office Action rejects claims 19 and 20 under 35 U.S.C. § 101 as allegedly "directed to non-statutory subject matter." Office Action, p. 2. The Office Action states "[c]laims 19 [and] 20 call for 'a computer program product, i.e., a computer program tangibly embodied in an information carrier', e.g., in a node-readable storage device or in a propagated signal, which is a signal per [se]." Office Action, p. 3. Applicants respectfully disagree. However, in order to advance prosecution, Applicants have amended the specification to remove the description of a "propagated signal". Therefore, claim 19 clearly recites a statutory device and the rejection is therefore improper. Claim 20 is cancelled. Applicants respectfully request the Examiner to withdraw the rejection of claim 19 under 35 U.S.C. § 101.

## **III. Rejection of Claims 1-8 and 19-22 under 35 U.S.C. §103(a)**

Applicants respectfully traverse the rejection of the claims under 35 U.S.C. § 103(a) as being unpatentable over *Barrett* in view of *Sridhar*. No *prima facie* case of obviousness has been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The

mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include] [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1, as amended, defines a method of grid computing, including, “sending a **request for data** describing an **application process in a grid computing** environment, wherein the data **identifies the application process** and the **computational processing requirements** of the application process; [and] **receiving the data** describing the **application process** in the grid computing environment” (emphasis added). The Office Action alleges *Barrett* discloses “sending a request for data describing the application process and its requirements; and receiving data describing the application process and its requirements,” by referencing column 9, lines 9-59 and column 11, lines 14-51 of *Barrett*. Office Action, p. 8. However, the Office Action is incorrect. These passages of *Barrett* describes the exchange of identification

signals between the multipath channel interfaces. Col. 9, lines 9-59. These identification signals are used to determine active communication channels and buffer sizes for channel reception blocks. *Id.* Therefore, *Barrett* does not disclose “data describing an application process in a grid computing environment, wherein the data identifies the application process and computational processing requirements of the application process,” as recited in amended claim 1.

Applicants further submit that the Office Action fails to point out, and there is no teaching or suggestion of, “grid computing” in *Barrett*. Therefore, *Barrett* fails to teach or suggest at least “sending a **request** for **data** describing an **application process** in a **grid computing** environment, wherein the data **identifies** the **application process** and the **computational processing requirements** of the application process; [and] **receiving** the **data** describing the **application process** in the grid computing environment” as recited in claim 1 (emphasis added).

*Sridhar* fails, and is not relied on in the Office Action, to cure the above-mentioned deficiencies of *Barrett*. That is, *Sridhar* also fails to teach, suggest, or make obvious “sending a **request** for **data** describing an **application process** in a **grid computing** environment, wherein the data **identifies** the **application process** and the **computational processing requirements** of the application process; [and] **receiving** the **data** describing the **application process** in the grid computing environment” (emphasis added) as recited in claim 1.

In view of the deficiencies of the references discussed above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 1. Thus, the

Office Action has failed to clearly articulate a reason why claim 1 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1 and the rejection under 35 U.S.C. § 103(a) must be withdrawn. Claims 3-8 are also allowable at least due to their depending from claim 1.

Independent claims 19 and 21, while of different scope from claim 1 and each other, recite elements similar to those of claim 1 and are thus also allowable for reasons similar to those discussed above for claim 1. New claims 23 and 24 are also allowable at least due to their dependence from independent claim 21.

For at least these reasons, a *prima facie* case of obviousness has not been established with respect to the claims and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

### **CONCLUSION**


In view of the foregoing, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:   
Erin M. Fife  
Reg. No. 61,332